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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/040,595	01/07/2002	Robert G. Severson	500355	2692
23626	7590	03/16/2004	EXAMINER	
LEYDIG VOIT & MAYER, LTD 6815 WEAVER ROAD ROCKFORD, IL 61114-8018			ACKUN, JACOB K	
			ART UNIT	PAPER NUMBER
			3712	
DATE MAILED: 03/16/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/040,595	Applicant(s) SEVERSON, ROBERT G.	
	Examiner Jacob K. Ackun Jr.	Art Unit 3712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3 are rejected under 35 U.S.C. 102(b or e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Dieckmann, Barnes or any of the non-patent documents of record, all of the foregoing references cited by the applicant. Structurally all that claim 1 requires is a cylindrical elastomeric object having a top and bottom surface and having the claimed diameter to height ratio. Such a structure is considered to be notorious in the prior art. For example, each of the references above discloses an object having all of the noted features. Note elements 32 in Dieckmann, the Fig 3 embodiment in Barnes (and note here the express teaching of a diameter of 5 inches and a thickness of a half inch as one possibility) and the circular or cylindrical objects intended to be stepped on in each of the cited non-patent documents. Since each of the aforementioned references disclose all of the structural elements of the claims, they are presumed to be inherently capable of all of the claimed functions, such as

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use in a game set having multiple elements, whether or not the functions are expressly taught in the references.

In the event any of the aforementioned prior art objects are later deemed not to anticipate the claims because they lack elastomeric material or the specific dimensions set forth in claim 1, it would have been obvious to provide the missing elements for the prior art cylinders as an obvious choice of design, to make them more durable or to make them easier to use.

4. Claims 4-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied in paragraph 3 above and further in view of either Reiner et al. or Quade (cited by applicant) or official notice hereby taken that gripping surfaces and projections for gripping are conventional. The references as applied in paragraph 3 may not teach a gripping layer or projections for gripping (although at least some teach construction from non-skid material). On the other hand, the applicant certainly does not appear to be the first to provide articles to be stepped on such as stairs, mats etc. with gripping surfaces or projections. For example, Quade teaches the gripping layer (note that Quade teaches partial formation from material to exert friction on another surface in column 2) and projections 4 for gripping, and Reiner teaches projections 28 for gripping. Especially since the mats and other cylindrical objects in the references applied in paragraph 3 are intended to be stepped on or jumped on, it would have been obvious in view of Reiner or Quade or the official notice noted above, to provide them with a gripping layer and/or projections on the top and bottom surfaces thereof, for the purpose of facilitating better adherence of the objects to substrates below, and better

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adherence of users feet or shoes to the top surface of the objects, all of this to permit or improve functioning of the objects as they were intended.

5. Claims 20-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dieckmann, Barnes the non patent literature cited by the applicant, Reiner, Quade or Timmerman. Each of the references discloses most of the elements of the claims, but may lack specific elements such as one or more of the conditions set forth in claim 20. However, it would have been obvious to use each of the prior art structures as claimed for the purpose of enhancing their enjoyment. The methods claimed and the listed conditions are not considered novel or unobvious to one having ordinary skill in the art concerned with games or play of the kind under consideration here.

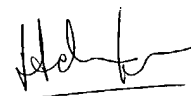
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob K. Ackun Jr. whose telephone number is (703)308-3867. The examiner can normally be reached on Monday through Friday 8.30AM-5.00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (703)308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR

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system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Jacob K. Ackun Jr.', written over a horizontal line.

Jacob K. Ackun Jr.
Primary Examiner
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J.A.